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RESPONSE UNDER 37 C.F.R. §1.116
EXPEDITED CONSIDERATION REQUESTED

PATENT
HP 30004783 US
LHB 1509-192

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Peter MACER et al. Conf.: 4609
Serial No.: 09/894,917 Art Unit: 2671
Filed: June 29, 2001 Examiner: J. Swearingen
For: PORTABLE ENTERTAINMENT MACHINES

REQUEST FOR RECONSIDERATION

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

May 23, 2005

Sir:

The following remarks are responsive to the Office Action mailed March 23, 2005, in connection with the above-identified application.

Applicants thank the Examiner for the thorough consideration given the present application. Claims 42-99 are pending; claims 1-41 are withdrawn from consideration.

Applicants traverse the rejection of claims 42-59 under 35 U.S.C. §101 as being directed to non-statutory subject matter. Independent claim 42, upon which claims 43-59 depend, recites, "A computer program product comprising a computer usable medium or a memory for use in a computer, the medium or memory having...." Because a memory (e.g., a ROM or an EPROM or EEPROM) is an article of manufacture, claims 42-59 comply with the requirements

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of 35 U.S.C. §101. If he adheres to this rejection, the Examiner is requested to identify a memory that is not an article of manufacture and/or to indicate why a memory is not an article of manufacture.

Applicants traverse the rejection of claims 42-44, 50, 51, 53, 60-63, 65-67, 73-75, 77, 91, and 94 under 35 U.S.C. §102(e) as being anticipated by Hawkins et al. (U.S. 6,516,202). The Office Action contends Hawkins discloses all features of claims 42-44, 50, 51, 53, 60-63, 65-67, 73-75, 77, 91, and 94. The rationale on pages 2-10 of the Office Action includes many assertions of inherency that do not comply with the judicial pronouncements on the subject. The fact that a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981). To establish inherency, extrinsic evidence must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference and that it would be so recognized by persons of ordinary skill in the art. Inherency may not be established by possibilities or probabilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Roberston*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). In relying upon a theory of

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inherency, the Examiner must provide a basis in fact or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (B.P.A.I. 1990).

In connection with claims 42, 60, and 99, the Office Action alleges Hawkins' cellular telephone has a manually operable control adapted to permit the user of the telephone to exercise at least some control over swapping of digital objects between the digital object stores of two or more such telephone entertainment machines. To support this position, the Office Action states in item 81 on page 22:

The Examiner believes that Hawkins does support swapping of files. Hawkins allows for file transmission using cellular technology. Cellular technology is bidirectional. See Hawkins, column 4, lines 5-14. Swapping files is at its most basic definition a request-response situation for a network. One computer requests a file and another computer responds with that file. Then the other computer requests a file and the first computer responds with that file. This is the basis of TCP/IP--the cornerstone of modern networking. In TCP/IP, one computer requests a file from another computer and that computer responds. The first computer acknowledges receipt of the file. Hawkins utilizes cellular data services. See Hawkins, column 6, lines 48-60. See Hawkins, column 7, lines 29-35. The Examiner believes cellular data services would function inherently using TCP/IP when connected to modern networks. Because TCP/IP is inherent from this line of reasoning, file swapping would be likewise inherent.

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This statement does not satisfy the inherency requirement because it does not indicate the Hawkins cellular telephone necessarily supports file swapping. The statement admits this by twice saying, "The Examiner **believes...**" Belief by the Examiner is not enough to establish inherency. Proof is necessary. There is no proof.

In rejecting claims 49 and 73, the Office Action says Hawkins' indicators or alerts include a signal strength indicator (column 7, lines 30 and 31) and a message indicator (line 30) that can indicate either a voicemail message or a text/e-mail message (line 33) is available to be received for alerting a user to the availability of a potential swap. There is nothing in Hawkins indicating the alert has anything to do with the availability of a potential swap.

In discussing claims 50 and 74, the Office Action contends, "By removing the cellular component during transmission of a digital object, a user is able to transmit an incomplete digital object. Since another machine would only receive a portion of a digital object transmitted if the transmission were terminated in this manner, it would in essence be sampling the digital object for the user." However, these operations are speculations by the Examiner. They do not necessarily occur. Also, these physical operations discussed about claims 50 and 51 in the Office Action are not the result of a computer program product comprising a computer-readable medium or a memory for use in a computer. The

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discussion about the applicability of Hawkins to claim 51 is not germane to the limitations of claim 51.

In discussing claim 60, the Office Action states Hawkins discloses signals that are representative of a digital game object and that Hawkins discloses a cell phone with a program stored in a memory that causes a transceiver of the cell phone to be coupled to be responsive to a store for digital game objects and to the transceiver of another machine so the user of the cell phone can, by using the control, exercise at least some control over swapping of digital game objects between the digital store of the other entertainment machine. The rationale for this position is set forth on page 6 of the Office Action:

Because the cellular element can be utilized as a telephone (Column 2, lines 20-21), it is inherent that it can both receive and transmit signals, and a manually operable control adapted to permit the user of the entertainment machine to exercise at least some control over swapping of digital objects between the digital object stores of two or more such entertainment machines." (The mobile computer system includes a touch screen (Figure 3A, items 305 and 310). Both the push buttons and the touch screen require manual operation by the user.

The foregoing statement in the Office Action is not an adequate explanation of why swapping of digital game objects is inherent.

In discussing claim 87, the Office Action says:

Because the mobile computer system utilizes cellular technology, it is able to be in range of any similar machine that is on a telephone network connected to a cell tower by any telephonic means. Hawkins discloses a machine provided with an alert device (FIG. 8A of

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Hawkins discloses a screen (item 810) at the top of which indicators are displayed. These indicators, or alerts, include a signal strength indicator (column 7, lines 30-31) and a message indicator (line 30) that can indicate either a voicemail message or a text/e-mail message (line 33) is available to be received for alerting a user to the availability of a potential swap. (The signal strength indicator tells whether the phone is in range of receiving data objects. If a message indicator is present, the user is able to make a decision on whether to download the voicemail, text or e-mail message. If the user decides to download the message, the mobile computer system must send information from the transmitter to the similar machine to retrieve the message. Because data is transmitted and received by the mobile computer system to a similar machine in order to download the message, data is swapped with a similar machine.

However, this statement ignores the requirement of claim 67 about (1) user information about game objects enabling a machine user to make a decision on whether to proceed with a potential swapping transaction, and (2) a program storing control steps for the operations.

The Office Action, item 82, page 22, indicates the word "game" in connection with "game object" and "digital game object" has not been given patentable weight because what is considered a game varies greatly from person to person. This position is contrary to the requirements of *In re Wilson*, 424 F.2d 1382, 1385, 1650 USPQ 494, 496 (CCPA 1970), which held that all words in a claim must be considered in judging the patentability of that claim against the prior art. The words of a claim must be given their plain meaning unless the specification of the application provides a clear definition. *In re Zletz*, 893 F.2d

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319, 321, 13 USPQ2d 1320, 1322 (Fed. Circ. 1980); *MSA Investments Co. v. Carolwood Corp.*, 259 F.3d 1335, 1339-40, 59 USPQ2d 1856, 1859-60 (Fed. Cir. 2001). When not defined in the specification, the plain meaning of a word must be in accordance with the interpretation of those of ordinary skill in the art. *Rexmore Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001); *Toro Co. v. White Consolidated Industries, Inc.*, 199 F.2d 1295, 1299, 53 USPQ2d 1065, 1067 (Fed. Circ. 1999).

In the present case, there is no doubt that those skilled in the art know what the terms "game object" and "digital game objects" mean. The words "object," "personal computer game," and "gamer" are defined in *Webopedia*, the online encyclopedia dedicated to computer technology as:

object: Generally, any item that can be individually selected and manipulated. This can include shapes and pictures that appear on a display screen as well as less tangible software entities. In object-oriented programming, for example, an object is a self-contained entity that consists of both data and procedures to manipulate the data. (See Exhibit 1.)

personal computer game: Personal computer games are commonly referred to as *computer games* or *PC games*. They are played on the personal computer with standard computer interface devices such as they keyboard and mouse, or a joystick or gamepad. Video feedback is received by the gamer through the computer screen, and sound through speakers or headphones. (See Exhibit 3.)

gamer: A person who plays video, Internet or computer games. (See Exhibit 2.)

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The first three pages of a Google search for "computer games" resulted in the enclosed printout of Exhibit 4. Exhibit 5 indicates Stanford University offered a course in March 2005 on computer games. Based on the foregoing, it is apparent that one of ordinary skill in the art related to this application knows the meaning of "game object" and "digital game object." Consequentially, the Examiner cannot ignore these terms and not give them patentable weight.

The rejections of the remaining claims under §102 and/or §103 are wrong because the claims include the same limitations as the independent claims. The secondary references do not cure the deficiencies of Hawkins.

Allowance is in order.

To any extent necessary, Applicants hereby request an extension of time in which to respond to the outstanding Office Action and hereby authorize the Commissioner to charge any required fees not otherwise paid, including application

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processing, extension, and extra claims fees, to Deposit Account
No. 08-1225.

Respectfully submitted,

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